

REMARKS

Claims 1-3 have been amended to delete reference to prodrugs, hydrates, solvates and crystal forms as specific species. In addition, claim 1 has been amended to require that B and Y are both phenyl and the substituents have been edited to delete reference to heterocycles as required by the restriction requirement. Similar changes have been made to claim 2. In addition, claim 3 has been edited to delete compounds that are no longer within the scope of claim 1. Claims 5 and 6 have been canceled. These changes are in accordance with the restriction requirement. Claim 4 has been clarified to refer to a pharmaceutical composition, similar claims 7 and 8 dependent on claims 2 and 3 have been added.

In addition, claim 1 has been amended to permit four substituents on B in light of what is clearly an inadvertent error. This is apparent from inspecting the compounds in claim 3 where, for example, the second, fourth, sixth and eighth compounds (reading each line from left to right) each contains four substituents. This is clearly, then, an inadvertent error.

Finally, claim 1 has been amended to insert a proviso to avoid the coincidental anticipation noted by the Examiner with certain compounds of the prior art.

No new matter has been added and entry of the amendment is respectfully requested.

Election / Restrictions

Applicants believe the restriction requirement has now been complied with. Should inadvertent inclusion of non-elected subject matter be noted, a telephone call to the undersigned is respectfully requested in order to make the appropriate correction.

The Rejection Under 35 U.S.C. § 102

Claims 1, 2 and 4 were rejected as anticipated by Thorarensen, *et al.* (US2004/0110802) and Riordan (U.S. 5,756,524). Claim 3 (and 7-8) is free of this rejection.

As to Thorarensen, the Office points to the last four compounds recited in column 294. All of these compounds have COOH substituted at the ortho position in the phenyl that represents Y and R¹ is H in all of these compounds. Thus, the proviso in claim 1 clearly excludes these compounds and anticipation is overcome.

As to Riordan, compounds 80, 169 and 234 are specified. Compound 80 does not anticipate as the compounds of the invention do not permit further substitution on the pyridine ring and compound 80 contains an additional methoxy at position 2 thereof. Compound 169 does not fall within the scope of the present claims as there is no counterpart of B as phenyl and in any event, the pyridine is substituted 2,5 rather than 3,5. Compound 234 is excluded by the proviso since it contains COOMe at the 2 position of the counterpart to Y and R¹ is H.

Applicants note that WO1995/025723, which appears to be the application on which Riordan is based, discloses compounds similar to those of Riordan, except that in addition to substitution by COOR, the 2 position of Y can be substituted by CN or NH₂. Accordingly, these have been included in the proviso in claim 1, and these compounds are excluded from claim 1 as well.

In view of the amendment, the rejection for anticipation may be withdrawn.

The Rejection Under 35 U.S.C. § 103

Claims 1, 2 and 4 were rejected as assertedly obvious over Thorarensen, *et al.*, and Riordan, *et al.* Again, claim 3 (and 7 and 8) is not subject to this rejection.

As to Riordan, the compounds of claims 1 and 2 are not obvious because Riordan teaches that what is essential to the activity of the compounds disclosed therein is the presence of a particular substituent in position 2 relative to the nitrogen designated A in the present invention. In contrast, the essential feature of the compounds of the present invention is a 3,5 substitution on the pyridine nucleus. There is no motivation to provide compounds with the specific arrangement set forth in the present claims; the presence of compounds that fall within the genus of the present claims is no more than an accidental coincidence. There is nothing in Riordan that teaches the requirement for 3,5 substitution on a pyridine ring wherein one substituent is phenyl and the other is a phenyl carboxamide.

With respect to Thorarensen, again, there is no teaching of a required 3,5 substituent on pyridine. The generic formula set forth in Thorarensen is a derivatized benzene group with a required ortho substituent. Any coincidental overlap is not suggestive of the invention itself.

This is aside from the clear distinction with respect to new claims 7 and 8 as the compounds of Riordan are fungicides and those of Thorarensen are simply disinfectants.

Accordingly, as the cited documents do not suggest the required features of the presently claimed compounds, they do not suggest the compounds of the invention and the rejection may be withdrawn.

The Rejection Under 35 U.S.C. § 112

Claims 1-3 were rejected under this statutory section based on the inclusion of polymorphs, hydrates, solvates and prodrugs in the scope of the claims. This basis for rejection is obviated by amendment deleting reference to these specific features. Applicants are aware that these forms are included generically within the scope of the claims.

The Rejection Under 35 U.S.C. § 112, Paragraph 2

This is obviated by amendment as well.

Conclusion

In view of the amendments to the claims and specific exclusion of any coincidental overlap with the prior art compounds, the subject matter of claims 1-4 and 7-8 is free of the art. Further, the claims have been restricted to the elected invention. Therefore, applicants respectfully request that claims 1-4 and 7-8 be passed to issue.

Should minor issues remain that could be resolved over the phone, a telephone call to the undersigned is respectfully requested.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 415852000700.

Respectfully submitted,

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